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10/531,686	04/15/2005	Norimasa Hiramatsu	123491	3726
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/531,686

Applicant(s)

HIRAMATSU ET AL.

Examiner

LOREN CHAUHAN

Art Unit

2193

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date 4/15/2005, 3/2/2006, 10/24/2006, 6/29/2007
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-27 are pending for examination in this application.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 19-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

- a. As per claim 19, recites "An identification information storing program which is a computer readable program"; but the body of the claim is reasonably interpreted as a "program per se".
- b. As per claim 24, recites "A predetermined information changing program which is a computer readable program"; but the body of the claim is reasonably interpreted as "program per se".
- c. As per claim 25, recites "A terminal operating program which is a computer readable program"; but the body of the claim is reasonably interpreted as "program per se".
- d. In each instance, Applicant is advised to incorporate language wherein "the program is executed by a processor to enable the device to perform operations comprising" to fix the deficiency.

- e. Claims 20-23 are rejected for similar reasons as discussed for their respective parent claims, as they fail to present any limitations that resolve the deficiencies of the claim from which they depend.

Claim Rejections - 35 USC § 112

Claims 20-23 and 26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The cited claims are claimed as dependent claims but operate as independent claims. The claims should be amended as being independent claims.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 10, 19-23 are rejected under 35 U.S.C. 102(b) as being anticipated by Yui (US Pat. No. 5,390,331).

6. As per claims 1 and 10, Yui teaches the invention as claimed including an information terminal device (fig. 2; col. 3, lines 32-33) comprising a first internal memory for storing identification information to identify a storage medium (20, fig. 2; col. 3, lines 36-37; col. 2, lines 9-11; e.g. ID code memory), which identification information is read from the storage medium (4, 32, fig. 2; col. 2, lines 35-36; col. 4, lines 25-26; e.g. ID code stored in ID card memory in IC card is read out), the storage medium being detachably installed in the information terminal device (col. 4, lines 21-22; e.g. whether IC card is connected to the apparatus body).

7. As per claim 19, Yui teaches the invention as claimed including an identification information storing program which is a computer readable program (Abstract) for causing an information terminal device in which a storage medium is detachably installed (col. 4, lines 21-22; e.g. whether IC card is connected to the apparatus body) to execute operations comprising:

- a first operation of reading identification information from the storage medium for identifying the storage medium (4, 32, fig. 2; col. 2, lines 35-36; col. 4, lines 25-26; e.g. ID code stored in ID card memory in IC card is read out); and

- a second operation of storing the identification information read in the first operation in an internal memory (20, fig. 2; col. 3, lines 59-60; e.g. ID code memory 20 stores the ID code given to the IC card).

8. As per claim 20, Yui teaches a storage medium on which the identification information storing program is stored (17, fig. 2; col. 3, lines 36-37).

9. As per claim 21, Yui teaches an information terminal device comprising:
program reading means for reading the identification information storing program from the storage medium as claimed in claim 19 which is detachably installed in the information terminal device (21, 33; fig. 3);

predetermined information storing means for storing predetermined information read by the program reading means in an internal memory according to the predetermined information storing program (col. 2, lines 6-7; e.g. a memory device means for storing an application program); and

program deleting means for deleting the predetermined information storing program on the storage medium after the predetermined information has been stored in the internal memory by the predetermined information storing means (col. 2, lines 26-27; e.g. means for clearing memory contents of said memory means).

10. As per claim 22, Yui teaches wherein the program deleting means also deletes the identification information storing program read from the storage medium by the program reading means (col. 2, lines 26-27; e.g. means for clearing memory contents of said memory means).

11. As per claim 23, Yui teaches wherein the program reading means reads the identification information storing program before predetermined information different

from the identification information is read from the storage medium (A2, fig. 3; col. 4, lines 25-26; e.g. ID code stored in the ID code memory in the IC card is read out).

12. Claim 27 is rejected under 35 U.S.C. 102(e) as being anticipated by Nakajima (US PG-Pub. No. 2003/0100374).

13. As per claim 27, Nakajima teaches the invention as claimed including a center comprising:

information management means for storing information supplied from an information terminal device, said information being about modification of predetermined information stored in an internal memory of an information terminal device (fig. 3, paragraph [0022], lines 1-5; e.g. memory management area contains application data and media data and is used for performing data control on the updating data),

information providing means for providing the information about modification of the predetermined information managed under the information management means under a predetermined condition (fig. 3, paragraph [0022]; e.g. media data is used for determining whether the updating data is compatible with the corresponding machine).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. Claims 2-9, 11-18 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yui (US Pat. No. 5,390,331) in view of Nakajima (US PG-Pub. No. 2003/0100374).

16. As per claim 24, Yui teaches the invention substantially as claimed including a predetermined information changing program which is a computer readable program for causing an information terminal device in which a storage medium is detachably installed to execute operations (Abstract) comprising:

a first operation of determining whether identification information for identifying the storage medium, which has already been stored in a first internal memory of the information terminal device, corresponds to the identification information of the storage medium now installed in the information terminal device (col. 3, lines 62-65; e.g. comparator unit compare the ID code stored in the ID code memory with the ID code read out from the IC card).

17. However, Yui does not explicitly teach a second operation of replacing predetermined information, which is different from the identification information, stored

in the second internal memory with predetermined information on the storage medium now installed in the information terminal device if both identification information is determined to corresponds each other in the first operation.

18. Nakajima teaches a second operation of replacing predetermined information, which is different from the identification information, stored in the second internal memory with predetermined information on the storage medium now installed in the information terminal device if both identification information is determined to corresponds each other in the first operation (S3-S7, fig. 7; paragraphs [0038]-[0040]; e.g. it is determined that the media data corresponds to the machine unit, then program information area is readout from the tag (which is now connected through the antenna (see paragraph [0018], lines 5-12)) and then overwrites the whole memory with the data).

19. Therefore it is obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Yui and Nakajima so that it will update the software which are already installed and compatible with the system and thus reducing the piracy and illegal distribution of the software.

20. As per claim 25, Yui teaches the invention substantially as claimed including a terminal operating program which is a computer readable program for causing an information terminal device in which a storage medium is detachably installed to execute operations comprising:

a first operation of determining whether identification information for identifying the storage medium is stored in a first internal memory (col. 3, lines 62-65; e.g. comparator (col. 3, lines 62-65; e.g. comparator unit compare the ID code stored in the ID code memory with the ID code read out from the IC card) ; and a third operation of causing the information terminal device to operate according to the predetermined information stored in the second internal memory by way of the second operation (col. 2, lines 12-15; e.g. means for executing the application program stored in the memory device).

21. However, Yui does not explicitly teach a second operation of storing predetermined information on the storage medium, which is now installed in the information terminal device, in a second internal memory of the information terminal device under a predetermined condition when it is determined in the first operation that the identification information is not stored in the first internal memory.

22. Nakajima teaches a second operation of storing predetermined information on the storage medium, which is now installed in the information terminal device, in a second internal memory of the information terminal device under a predetermined condition when it is determined in the first operation that the identification information is not stored in the first internal memory (S3, S4, S7, fig. 7; paragraph [0032]; e.g. if application data indicates 03 hexadecimal, updating data is added to the data of the memory).

23. Therefore it is obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Yui and Nakajima so that it will update the software which are already installed and compatible with the system and thus reducing the piracy and illegal distribution of the software.

24. As per claim 26, Nakajima teaches a storage medium on which the terminal operating program as claimed in claim 25 is stored (paragraph [0018] lines 5-10; e.g. the non-contact integrated memory tag, which stores updating data is embedded in a paper medium).

25. As per claim 2, Yui teaches the invention substantially as claimed including storing operation control means for permitting a storing operation of storing the identification information in the first internal memory if the identification information is not stored in the first internal memory (col. 4, lines 6-8; col. 3, lines 59-61; e.g. ID code memory stores the ID code given by IC card under predetermined condition).

26. Yui does not teach forbidding or limiting the storing operation after the identification information has been stored in the first internal memory.

27. Nakajima teaches data contained in non-contact integrated memory tag will be erased after it comes in contact with the device (paragraphs [0033]; [0018] lines 5-11), thus teaches forbidding or limiting the storing operation.

28. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention was made to combine the teachings of Yui and Nakajima so that the use of the software application can be limited to a particular device and illegal distribution of the software can be prevented.

29. As per claim 3, Nakajima teaches wherein the storing operation control means permits the storing operation of storing the identification information in the first internal memory if the identification information is not stored in the first internal memory, before predetermined information different from the identification information is read from the storage medium (S3, S7, fig. 7; paragraph [0032]; e.g. updating data is added to the data memory).

30. As per claim 4, Yui teaches wherein the storing operation control means also permits the storing operation of storing the identification information in the first internal memory under a predetermined condition even if the identification information is stored in the first internal memory (col. 3, lines 59-61).

31. As per claim 5, Yui teaches a second internal memory for storing predetermined information different from the identification information read from the storage medium which is detachably installed in the information terminal device (18, fig. 2; col. 3, lines 46-47; e.g. RAM is used to process an application program data on the IC card).

32. However, Yui does not explicitly teach storage information controlling means which replaces the predetermined information stored in the second internal memory with predetermined information on the storage medium now installed in the information terminal device if the identification information of the storage medium now installed corresponds to the identification information already stored in the first internal memory.

33. Nakajima teaches storage information controlling means which replaces the predetermined information stored in the second internal memory with predetermined information on the storage medium now installed in the information terminal device if the identification information of the storage medium now installed corresponds to the identification information already stored in the first internal memory (paragraph [0022]).

34. As per claim 6, Yui teaches information executing means which executes an operation according to the predetermined information stored in the second internal memory (14, fig. 2; col. 2, liens 13-14; e.g. means for executing the application program stored in the memory device).

35. However, Yui does not teach wherein the storage information controlling means causes the second internal memory to store the predetermined information on the storage medium now installed in the information terminal device under a predetermined condition when the identification information is not stored in the first internal memory.

36. Nakajima teaches the storage information controlling means causes the second internal memory to store the predetermined information on the storage medium now installed in the information terminal device under a predetermined condition when the identification information is not stored in the first internal memory (S3, S7; fig. 7; paragraph [0032]).

37. As per claim 7, Nakajima teach uploading means which supplies information about modification of the predetermined information in the second internal memory to a predetermined center (paragraph [0018] lines 9-11; paragraph [0005]).

38. As per claim 8, Nakajima teaches installation urging means which executes an operation to urges the installation of the storage medium when the installed storage medium, from which the predetermined information is read, is detached from the information terminal device (paragraph [0044]).

39. As per claim 9, Yui and Nakajima do not explicitly teach the installation urging means stops at least a part of operation. However, it is well known in the art that when an installation device is detaches from information processing unit the installation operation will stop. therefore is obvious to one of ordinary skill in the art to use this mechanism so that the proper software will be installed on the device.

40. As per claims 11-18, they are the method claims of the claims 2-9, therefore; they are rejected for the same reason as per claims 2-9 above.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LOREN CHAUHAN whose telephone number is 571-270-1554. The examiner can normally be reached on Mon.-Thr. 9:30-5:00 (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lewis Bullock can be reached on 571-272-3759. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lewis A. Bullock, Jr./
Supervisory Patent Examiner, Art Unit 2193

Loren Chauhan
Examiner
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